

REMARKS

This Amendment is in response to the Office Action mailed October 5, 2006. In the Office Action, claims 11-32, 60-61, 66-75 and 81-84 were rejected under 35 U.S.C. §103(a). Applicant respectfully traverses the rejections in their entirety and respectfully requests reconsideration of the pending claims in light of the amendments and remarks made herein is respectfully requested. Claims 11-13, 66 and 73 have been amended and claims 60-61 have been cancelled without prejudice.

Request for Examiner's Interview

The Examiner is respectfully requested to contact the undersigned by telephone at the phone number listed below in order to coordinate an Examiner's interview. Applicant believes that the below-listed claims are in condition for allowance, but believes that a telephone conference to discuss the allowability of these claims would greatly facilitate the examination of the subject application. Moreover, Applicant respectfully submits that the Examiner has failed to fully identify the grounds for rejection, as evidenced by the fact that support for the rejection of claims 20-32 are not discussed in the outstanding Office Action.

Rejection Under 35 U.S.C. § 103

Claims 11 and 13-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schilling (U.S. Patent No. 5,359,182) in view of Kawan (U.S. Patent Application No. 2002/0062284) and Miyake (U.S. Patent No. 5,886,333). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, the combined teachings of the cited references fail to describe or suggest all the claim limitations.

With respect to independent claim 11 and those claims dependent thereon, in general terms, Applicant respectfully submits that neither Schilling, Kawan nor Miyake, alone or in any combination, describes or suggests the uploading of user information, such as credit card information, from an entity (e.g., issuer of the credit card) to the portable unit, where the user information is used for subsequent transactions with yet another entity. More specifically, respectfully submits that neither Schilling, Kawan nor Miyake, alone or in any combination, describes or suggests (i) *verifying and authenticating a user of the portable unit by the entity located at a first location*, the portable unit comprises internal memory including a first area to contain user information, and (ii) *uploading user information into the portable unit only after the*

user is verified and authenticated by the entity, the user information being subsequently provided by the portable unit to a business entity located at a second location for use during a transaction. Emphasis added.

In contrast, Kawan describes the downloading of information from a smart card (20) once the smart card (20) is validated. However, there is no teaching or verification by the entity, considered by the Examiner to be the debit/credit card, and uploading only if the user has been verified by the entity. The smart card does not perform such authentication, and thus, the alleged "entity" does not perform the authentication as claimed.

Furthermore, claim 12 is further directed to the embodiment where the user information is a drivers license number and the claimed method further comprises the operation of "prompting the user to select either displaying, downloading or printing the user information *where the display of the user information includes displaying a digital picture of the user, the drivers license number, name and physical characteristics of the user and where the downloading of the user information can be restricted to read-only.* Emphasis added.

Moreover, with respect to claims 20-32, the Office Action is devoid of an explanation of the grounds for rejection. Applicant respectfully requests the Examiner to provide evidence of such claim limitations being described or suggested in the teachings of the cited references.

Therefore, Applicant respectfully requests the Examiner to withdraw the outstanding §103(a) rejection as applied to claims 11 and 13-32 and respectfully requests the Examiner to discuss this matter further in a telephone conference.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schilling in view of Kawan, Miyake and Ramachandran (U.S. Patent No. 6,315,195). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established and incorporates the arguments set forth above. In addition, based on the dependency of claim 12 on independent claim 11, believed by Applicant to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicant reserves the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claim 12 is respectfully requested.

Claims 66-75 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ramachandran in view of Burger (U.S. Patent Publication No. 2002/0152123). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established.

For instance, with respect to independent claims 66 and 73, Applicant respectfully submits that neither Ramachandran in view of Burger, alone or in combination, describe or suggest uploading & downloading the drivers license information as claimed. Applicant respectfully requests the Examiner to withdraw the outstanding §103(a) rejection as applied to claims 66-75 in light of the amendments to claims 66 and 73 noted above. Applicant respectfully requests the Examiner to withdraw the §103(a) rejection and allow these claims.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case, and again, respectfully requests the Examiner to contact the undersigned attorney to discuss the allowability of these claims.

Respectfully submitted,

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Dated: March 5, 2007

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Susan McFarlane Date